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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,476	03/01/2004	Andrew Scott Gavin	PA2729US	2088
22830	7590	12/30/2004	EXAMINER	
CARR & FERRELL LLP 2200 GENG ROAD PALO ALTO, CA 94303			CHERUBIN, YVESTE GILBERTE	
			ART UNIT	PAPER NUMBER
			3713	
DATE MAILED: 12/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/791,476	Applicant(s) GAVIN ET AL.	
	Examiner Yveste G. Cherubin	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This office action is in response to the US Application No. 10/791,476 filed March 1, 2004. It is a continuation of US Application No. 10/268,278, now US Patent No. 6,705,945, which claims priority from Provisional Application 60/328,458, which claims priority from Provisional Application 60/328,482 filed October 10, 2001.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,705,945.

Although the conflicting claims are not identical, they are not patentably distinct from each other because similarly they both disclose providing game information via characters in a game environment. Although the claims of the instant invention are somewhat broader than the claims in the US Patent 6,705,945, the claim features

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recited in the US Patent No.6,705,495 are taught and disclosed by the aforementioned instant claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 10, 12-14, 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (6,296,570).

Regarding claims 1, 10, 12, 20-21 Miyamoto discloses a system and method of use wherein a video game is capable of providing game information to a user, monitoring a state of a character and presenting game information to the user via player-assisting items or advice, as shown in Figs 9-12 based on the state of the character, the game information being presented within a context of the game environment, 2:11-32, 12:23-67.

Regarding claims 2, 13, 18 Miyamoto discloses the state of the character being a position of the character, 18:11-17.

Regarding claims 3, 14, 19 Miyamoto discloses the state of the character being an action of the character, 18:11-17.

Regarding claim 4, Miyamoto discloses presenting game information further comprising presenting visual information as shown in Fig 9-12.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a. Claims 5-6, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Yamada (US Patent No. 6,319,121).

Regarding claims 5, Miyamoto discloses the claimed invention as substantially as shown above. Miyamoto is silent on presenting visual information to the user as a modification of the character. Yamada teaches a video game capable of presenting visual information (hit mark) to the user as a modification of the character, 4:35-45, 5:7-27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the feature cited above as taught by Yamada into the Miyamoto type system in order to provide realism to the game and perceive the hit location.

Regarding claims 6, 15 Yamada teaches modifying a direction of orientation of a head of the character (30) within a range of motion appropriate to the character as shown in Figs 4a-4b (consecutively)(head bending frontward in 4a and head bending backward after attack).

Regarding claim 16, Miyamoto discloses visual information module being further configured to modify a component of the character not controllable by the user, Figs 4a-4b (the character's head is not controlled by the user).

b. Claims 7-9, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Best (US Patent No. 5,393,073)

Regarding claims 7-9, Miyamoto discloses the game information as substantially as shown above. Miyamoto fails to disclose presenting audio information wherein the audio information is presented to the user as statements by another character in the game environment and wherein the other character throughout the game is a companion to the character that is present with the character throughout the game environment. Best teaches a video game presenting audio information. Best teaches a video game where audio information is provided to the user based on the position/action of the character in a gaming environment, see Figs 4 and 5, the audio statements being presented as statements from one character to another as shown in Fig 5 and wherein the other character is a companion to the character that is present with the character throughout the game environment, as shown. It would have been obvious to one of ordinary skill in the art to provide the audio information as taught by Best in the Miyamoto type system in order to add realism to the game and make it more appealing. Regarding claim 17, Best further teaches audio information module being further configured to monitor the state of the character in the game environment and to select an appropriate audio signal of the audio signals based on that state, as shown in Fig 4.

c. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Schwartz (US Patent No. 5,607,356).

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Regarding claim 11, Miyamoto discloses the claimed invention as substantially as shown above. Miyamoto fails to disclose audio information module configured to audibly provide information to the user by initiating playback of audio signals that represent statements between characters in the game environment. Schwartz teaches audio information module configured to audibly provide information to the user by initiating playback of audio signals that represent statements between characters in the game environment, 11:20-32. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the feature cited above by Schwartz into the Miyamoto type system in order to provide a sense of realism to the game.

Prior Art Citations

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. US Patent No. 6,652,384 to Kondo which teaches image processing device or placing a player character in a virtual space.
 - b. US Patent No. 6,168,524 to Aoki et al. which teaches enhancements in the sense of surprise in a RPG.
 - c. US Patent No. 4,752,069 to Okada which teaches video game which instructs the user how to play.

Conclusion

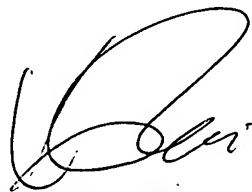
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yveste G. Cherubin whose telephone number is (571) 272-4434. The examiner can normally be reached on 9:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Xuan can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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AU3713